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**IBM Docket No. BLD920000040US1**

**REMARKS**

Claims 38-42 have been newly added. Claims 9, 13-17, 21, and 25-42 remain in the application.

Applicants respectfully request that the rejection of the claims presented be reconsidered and withdrawn in light of the amendments above and the discussion which follows and that the application be found in condition for immediate allowance.

**Request for Reconsideration of the Finality of the Rejection**

Applicants request that the Examiner reconsider the finality of the present rejection and that the finality be withdrawn. Applicants respectfully submit that independent claims 14 and 26 remain unamended as originally filed. In addition, claims 9, 13, 21, and 25 were merely rewritten in independent form and as such were not substantively amended. The Examiner performed a new search and came up with a new reference, Oseto, which was not of record and not submitted as part of an IDS. Therefore, Applicants respectfully submit, this is a new rejection based on new art. Furthermore, the search was performed **not** due to substantive amendment on the part of Applicants (at least one claim unamended). Please see MPEP 706.07 (a) and MPEP 706.07 (c) regarding withdrawal of the finality of a rejection.

On or about August 10 through August 12, Applicants attempted to telephonically contact the Examiner regarding this matter and left phone-mail messages outlining the specifics described above. The Examiner was out of the office during this time due to illness. On August 13, 2004, Examiner David Jones contacted the undersigned and acknowledged the prematureness of the finality of the rejection, agreed to withdraw the finality, and suggested that Applicants file a request for reconsideration. Later that day, Examiner Jones called the undersigned a second time to inform Applicants that a response on the merits is due at the same time as the filing

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of the request for consideration. Examiner Jones indicated that the finality of this rejection would be withdrawn and that he would respond in kind on the merits. Additionally, Examiner Jones advised that the response not be filed as a 37 C.F.R. § 1.116 amendment after final, but rather as a standard response. Hence, the dual title of this paper (Request for Reconsideration of Finality of Rejection and Response).

### **Claim Rejections**

#### **The Double Patenting Rejections**

Claims 9, 13-17, 21, and 25-37 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 4-27 of U.S. patent No. 6,577,907. In response, Applicants are filing herewith a terminal disclaimer to obviate the double patenting rejection.

#### **The 35 U.S.C. § 103 Rejections**

##### *Initial Argument Applicable to All Pending Claims (9, 13-17, 21, 25-30, 32, 34-42)*

Claims 9, 13-17, 21, 25-30, 32, 34-37 stand rejected under 35 U.S.C. Section 103(a) over Kobayashi et al. (US 6,245,487) in view of Oseto (US 6,097,797). Claims 31 and 33 stand rejected under 35 U.S.C. Section 103(a) over Kobayashi in view of Oseto in further view of Brossman et al. (US 6,266,150). In the rejections, the Examiner appears to have embarked on the tests for obviousness as outlined in Graham v Deere. Applicants contend these rejections are improper.

The Graham v Deere test for obviousness under 35 USC 103 is the subject matter of Section 2141 et seq in the Manual of Patent Examining Procedure. To briefly restate, the three inquiries set forth by the Court, in order, are to determine the

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applicable prior art, then determine the differences between that art and the claimed invention, and then determine whether a person of ordinary skill in the applicable art would know to make the modification necessary to arrive at those differences in view of the prior art applied.

As has been stated by the Court of Appeals for the Federal Circuit in considering matters on appeal from the Board of Appeals within the Patent Office, obviousness is a question of law (the Court citing Graham v Deere), but this determination occurs in the context of a factual inquiry regarding the scope and content of the prior art. This factual inquiry examines what a reference would have taught or suggested to one of ordinary skill in the art at the time the of the invention (the Court citing Northern Telecom v Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321). The Court has cautioned against focusing on the obviousness of the differences between the claimed invention and the prior art rather than the obviousness of the claimed invention as a whole as 35 USC 103 requires (citing Hybritech, Inc. v Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81) and against the use of hindsight reconstruction of what is disclosed in a prior art reference (citing Grain Processing Corp. v American Malze Products Co., 840 F.2d 902, 5 USPQ2d 1788). The Court has quoted approvingly from its decision in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, in which it said:

The mere fact that the prior art may [emphasis added] be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

On the latter point, the CAFC has said that the Patent Office, in determining the obviousness of a claimed invention that combines known elements, must determine whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination (citing Lindemann Maschinenfabrik GmbH v American Hoist and Derrick Co., 730 F.2d 1452, 221 USPQ 481).

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It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. See In re Semacker, 702 F.2d 989, 995; 217 USPQ 1, 6 (Fed. Cir. 1983). The reviewing court for the Patent Office requires proof by evidence in order to establish a *prima facie* case when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. See In re Knapp-Monarch Co., 296 F.2d 230, 232; 132 USPQ 6, 8 (CCPA 1961) and In re Cofer, 354 F.2d 664, 668; 148 USPQ 268, 271-272 (CCPA 1966). See also Section 2143 et seq of the MPEP.

Based on the above established law, Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of obviousness for all pending claims (Claims 9, 13-17, 21, and 25-42) because the Examiner's statement of motivation is not based on evidence made of record.

In the rejection, the Examiner presents the motivation to combine to be

"... to provide the ability to send and receive e-mail to and from other terminals machines through the LAN, without utilizing a system server for database information."

However, Applicants respectfully assert that the Examiner has not provided evidence in support of this statement.

The requirement that evidence for a motivation to combine is a necessary requisite is supported by extensive precedent including the recent In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) the Court reaffirming this principle states:

"... The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and

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combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors)...." (Lee op. cit. 1433).

If there are facts within the personal knowledge of the Examiner supporting the assertion that one of ordinary skill in the art would be motivated to combine or modify the cited references to achieve the claimed invention, Applicants respectfully request that such facts be made of record in an affidavit under 37 CFR 1.104(d)(2). Without such affidavit or other evidence, the Examiner's obviousness rejection based on non utilization of a system server for database information is unsupported by the record.

Because, for the aforesaid reasons, the Kobayashi and Oseto references cannot be properly combined in such manner as to render Applicants' claims unpatentable under 35 U.S.C. § 103. Applicants respectfully assert, therefore, that *all pending claims* 9, 13-17, 21, and 25-42 are patentable in light of Applicants showing that a *prima facie* case of obviousness has not been properly established.

*Claim Specific Arguments*

Even if the above arguments are found to be unpersuasive, each of the following claims are further believed to be patentable for reasons which are presented below.

*Claim 9*

With respect to Claim 9, Applicants respectfully assert that the Examiner has additionally failed to properly establish a *prima facie* case of obviousness because the combination fails to teach all of the limitations of Applicants' invention as claimed.

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Specifically, because (1) a remoteness criteria is not satisfied by the Examiner's combination and (2) Kobayashi's LAN 500-4 does not meet Applicants' "... second network interface ..." requirement. It is respectfully submitted that each of these two points, as will be explained in further detail hereinafter, is separately capable of standing on its own in defeating the Examiner's prima facie case. In addition, the two points can be collectively relied upon for the same purpose.

(1) Remoteness Criteria Not Satisfied by the Examiner's Combination

Claim 9 is believed to be further patentable because the Examiner's combination fails to include all elements recited in Applicants claim. Specifically, the Examiner's combination fails to disclose *at least* the following bold highlighted portions of claim 9:

... a memory coupled to and housed with said controller;  
said control program when executing on said controller  
further enabling a user to store a database of address  
information in said memory and to **selectively access one**  
of said database of address information stored in said  
memory **and a second database of address information**  
**stored remotely from said controller** and accessible  
through said first network interface. . . .

Thus, language expressly recited in Applicants claim requires the selective access to one of (i) a database of address information stored in a memory housed within the controller and (ii) a second database of address information stored **remotely** from the controller.

The Examiner's combination of Kobayashi and Oseto, on the other hand, fails to show or suggest this remote database, Applicants respectfully submit. The Official Action does not overtly address this **remoteness** limitation presently at issue. It appears to Applicants that the Examiner may be attempting to indirectly meet the

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remoteness requirement by presenting Kobayashi's address database 381 merely because it is contained within the server 3. That is to say, it appears that the Examiner is indirectly implying that because address database 381 is on the server that it must be remote (Official Action, page 7, last sentence), perhaps relying on the LAN connection between server 3 and multifunction unit 2 as evidence for remoteness. Should this be the Examiner's assertion, Applicants respectfully traverse the assertion. The rationale behind Applicants traversal is that Kobayashi's multifunction unit 2 is never remote from server 3. Kobayashi teaches a composite apparatus 1 which is *comprised* of a server 3 and a multifunction unit 2. As evidence supporting Applicants position that Kobayashi's server 3 is always local to multifunction unit 2, Applicants respectfully direct the Examiner's attention to the dotted lines depicted as 1 in figures 1, 7, and 8. These guidelines found in each of these figures denote that regardless of whether the LAN connection between server 3 and multifunction unit 2 is a private LAN (figure 7) or a standard LAN (figure 8), the two units comprise a single apparatus. Support for Applicants assertion that dotted line 1 represents a composite apparatus can be found in Kobayashi column 5 line 29.

Note that although several composite apparatus 1 are disclosed in Kobayashi, see Figure 9, access to the directory database 381 is always confined to within the composite apparatus 1 (a composite apparatus 1 = a server 3 paired with a specific multifunction unit 2). There is no disclosure in Kobayashi of an operating panel initiated directory request which is serviced by a composite apparatus 1 (see figure 9) which is other than the composite apparatus in which the operating panel resides. In other words, there are no composite-apparatus to composite-apparatus database requests disclosed in Kobayashi.

Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of selectively accessing one of (1) a database of address information stored in a memory housed within the controller and (2) a second database of address information stored **remotely**

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from the controller as required by Applicants' claims in combination with all other expressly recited elements and limitations.

(2) Kobayashi's LAN 500-4 Does Not Meet Applicants'  
"... second network interface..." Requirement

Claim 9 is further believed to be patentable because the Examiner's *prima facie* case combining Kobayashi and Oseto wrongly applies Kobayashi's LAN 500-4 as Applicants' expressly recited requirement for a second network interface. Specifically, the Examiner's attempted *prima facie* case fails to find identity with *at least* the following bold highlighted portions of claim 9:

9. . . . **a controller** which couples said image capture device  
and said printer interface, said controller **having**  
a first network interface which connects to an  
area network for bidirectional exchange of digital  
data; **and**  
a **second network interface which connects**  
**to a second network** for bidirectional exchange of  
digital data. . . .

Thus, the controller according to Applicants invention is a controller having a first network interface which connects to an area network and a second network interface which connects to a second network. That is, the controller is a controller having two interfaces. Applicants respectfully draw the Examiner's attention particularly to the use of the word –interface– in Applicants claim and to the definition of the word –interface–. Applicants have provided Appendix A and Appendix B from Whatis, found at [searchSmallBizIT.techtarget.com](http://searchSmallBizIT.techtarget.com), and Webopedia, found at [www .Webopedia.com](http://www.Webopedia.com). For which, the two definitions for –interface– which best supply are:

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... The physical and logical arrangement supporting the attachment of any device to a connector or to another device. ...

and

... the wires, plugs and sockets that hardware devices use to communicate with each other. ...

Meanwhile, on page 7, lines 5 and 13 of the present Office Action dated May 18, 2004, the Examiner appears to assert that Kobayashi's LAN 500-1 meets the required criteria for the area network connected to a first network interface, and that LAN 500-4 somehow meets the requirement set forth by the limitation for the second network connected to the second network interface of Applicants claim 9 highlighted in bold above. However, since LAN 500-4 is coupled through LAN 500-1 (referring now to Kobayashi figure 9), LAN 500-4 cannot be the second network recited in Applicants claim because the second network, in order to meet the limitations of Applicants claim 9, must be *connected* to the controller through a second network *interface* and not merely coupled through the first network interface. Considering the definition of ~~interface~~ above, the Examiner's assertion of LAN 500-4 coupled through LAN 500-1 (the area network connected to the first network interface) does not meet the above bold highlighted criteria for a controller having a first network interface which connects to an area network and a second network interface which connects to a second network.

Indeed, the Examiner asserts that the requirement for a controller is met by the Equipment State Managing Part 27 of Kobayashi (Official Action, page 6, paragraph beginning with "a controller..."). Applicants respectfully traverse this assertion. At best, the Equipment State Managing Part 27 of Kobayashi in the Examiner's combination of Kobayashi and Oseto discloses a controller having a single network interface which connects to an area network from which access is available to a second network. In other words, missing is a second interface. In order for a proper prima facie case of

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obviousness to be made, the Examiner's combination would have to include all of the elements and limitations which are expressly recited in Applicants claim.

The Examiner states, on page 7 of the Official Action at line 11:

... As taught by Kobayashi that since a user is able to send to all of the different areas within the network, i.e. printer, client, server of network 500-1, but also to 500-4, therefore, it is shown that Kobayashi is doing what is claimed for selecting delivery of the digital record to any selected one said printer, said first network interface, and said second network interface. . . .

Applicants respectfully assert that even if this statement were true it does not meet the limitations of Applicants claim. Claim 9 specifically states:

9. . . a control program stored accessibly to and executable on said controller, said control program when executing enabling a user to select delivery of the digital record to a selected one of said printer interface, said first network interface, and **said second network interface** . . . .

Missing is the delivery of the digital record to the second network interface, on which the Examiner is silent. Instead the Examiner asserts that the digital record is delivered to a second network, LAN 500-4, which as established above is delivered indirectly through coupling via the first network interface LAN 500-1.

To illustrate the point that Applicants are attempting to make, Applicants will supply parenthetical statements, in italics, to the Examiner's statement to indicate how Applicants are reading the Examiner's application and to show how it is that the Examiner fails to find identity with the delivery of the digital record to the second network interface.

... As taught by Kobayashi that since a user is able to send to all of the different areas within the network, i.e. printer

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(printer interface), client (*first network interface*), server of network 500-1 (*first network interface*), but also to 500-4 (*first network interface*). . . .

Thus, the "... second network interface..." requirement is not met.

Each of points (1) and (2) above is separately capable of standing on its own in defeating the Examiner's prima facie case. In addition, the two points can be collectively relied upon, if need be, for the same purpose. Therefore, Applicants believe that claim 9 defines patentable subject matter and respectfully requests that the Examiner remove the Kobayashi and Oseto references as inapplicable to Applicants' novel invention.

*New claims 38 and 39*

New claims 38 and 39 have been introduced into the application to explicitly divert the Examiner's present assertion that LAN 500-4 in case the Examiner maintains this assertion. Claims 38 and 39 explicitly state "... the second network being coupled through other than the first network interface . . . ." Should the Examiner maintain this assertion, claims 38 and 39 are believed to be patentable over the Examiner's combination.

*Claim 13*

Claim 13 contains all of the limitations argued above with respect to claim 9, with the exception that claim 13 includes the limitation that the delivery of the digital record be to any selected two of said printer, said first network interface and said second network interface. This difference is not currently under dispute. Therefore, Applicants incorporate by reference the arguments made with respect to claim 9 as they apply here to claim 13.

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**Claim 14**

Applicants incorporate by reference the arguments made above with respect to claim 9 under the heading "(2) Kobayashi's LAN 500-4 Does Not Meet Applicants' '... second network interface...' Requirement." These arguments apply equally to claim 14 as claim 14 expressly recites a controller having a first network interface which connects to an area network and a second network interface which connects to a second network. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Claim 14 is believed to be patentable or at least the reasons outlined in (2) above.

Additionally, Applicants respectfully submit that the Examiner's combination of Kobayashi and Oseto fails to teach or suggest at least the following bold highlighted section of Claim 14.

14. Apparatus comprising:
- an image capture device which generates a digital record;
  - a printer interface which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer;
  - a controller which couples said image capture device and said printer interface, said controller having
    - a first network interface which connects to an area network for bidirectional exchange of digital data; and

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a second network interface which connects to  
a second network for bidirectional exchange of digital  
data; and

a control program stored accessibly to and  
executable on said controller, said control program when  
executing enabling a user to select delivery of the digital  
record to **each and all** of said printer interface, said first  
network interface, and said second network interface.

Thus, the claim requires that a user be able to select delivery of the digital record to each and all, that is all three, of the printer interface, the first network interface, and the second network interface.

Applicants have made a thorough search of Kobayashi and Oseto and can find no such teaching for the delivery of a digital record through all three interfaces specified.

On page 12 of the Official Action, the Examiner cites column 16, lines 46-63 of Kobayashi which describe Kobayashi's figure 14 and 9 and asserts that what is described there is a teaching of "each and all." Applicants respectfully traverse this assertion. Applicants assert that what is being described in column 16, lines 46-63 of Kobayashi is singular print data being transferred to from a singular source to a singular destination. Note also that lines 54-63 of the cited portions of the reference which describe the disposition of the print result notification are irrelevant to where the print data is delivered and through which interfaces (i.e., where the print result notification is sent, which is a function of the Result Notification Processor 38 of Kobayashi, is a totally separate issue). Hence, column 16, lines 54-63, included here for convenience,

... the notifying destination of the print result does not have  
to be the computer 4 which makes the print request, and  
may be any computer 4 or any composite apparatus 1 within  
the network system shown in FIG. 9, for example.

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Furthermore, the notifying destination of the print result may be set in advance to an address peculiar to each print driver 42 or each print processor 31, and in this case, it is possible to give a priority to a notifying destination which is input from the screen 421 of the print driver 42 if such an input is made.

...

are irrelevant. There is no delivery of the print data to all interfaces required.

Thus, the Examiner has failed to find identity with the limitation for "... delivery of the digital record to **each and all** of said printer interface, said first network interface, and said second network interface. . ." expressly recited in Applicants claim 14. In light of the foregoing, Claim 14 is patentable over Kobayahi and Oseto or any combination of the cited references at least because the references fail to disclose or suggest these limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of selection of delivery for a digital record to each and all of (a) the printer interface, (b) the first network interface, and (c) the second network interface.

As a separate issue, Applicants assert *a fortiori*, as similarly argued in point (2) above with respect to claim 9, missing in the Examiner's attempt at a *prima facie* case against claim 14 is the delivery of the digital record to the second network *interface* (in the first place). Instead the Examiner asserts that the digital record is delivered to a second network, LAN 500-4, which as established above is delivered indirectly through coupling via the first network interface LAN 500-1.

To re-illustrate the point for claim 14, Applicants will supply parenthetical statements, in italics, to the Examiner's statement regarding claim 14 to indicate how

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Applicants are reading the Examiner's application and to show how it is that the Examiner fails to find identity with the delivery of the digital record to the second network interface.

. . . As taught by Kobayashi that since a user is able to send to all of the different areas with in the network, i.e. printer (*printer interface*), client (*first network interface*), server of network 500-1 (*first network interface*), but also to 500-4 (*first network interface*). . . .

Thus, the "... second network interface..." requirement is not met. The Examiner has essentially shown the digital record being delivered to a single interface, namely LAN 500 which the Examiner is reading as the first network interface.

Claim 14 is believed to be additionally patentable for at least these reasons.

**Claim 15**

With respect to claim 15, this claim is believed to be in condition for immediate allowance due to its dependence on independent claim 14 which is believed to be allowable. If an independent claim is nonobvious under 35 U.S.C.103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

In addition, claim 15 is believed to be patentable because the Address Database 381 of Kobayashi, which is asserted by the Examiner, is not remote. The lack of remoteness for address database 381 has been established in detail above in the arguments made with respect to claim 9. Those arguments under the heading of "(1) Remoteness Criteria Not Satisfied by the Examiner's Combination" are hereby incorporated by reference herein.

**Claim 16**

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With respect to claim 16, this claim is believed to be in condition for immediate allowance due to its dependence on independent claim 14 which is believed to be allowable.

*Claim 17*

Claim 17 is believed to be in condition for immediate allowance due to its dependence on independent claim 14 which is believed to be allowable.

Additionally, claim 17 contains all of limitations argued above with respect to claim 9 and all of the arguments made with respect to claim 9 apply equally here to claim 17. Applicants arguments labeled "(2) Kobayashi's LAN 500-4 Does Not Meet Applicants' '... second network interface...' Requirement" have already been incorporated by reference into independent claim 14 from which the present claim 17 depends. Applicants hereby also incorporate by reference those arguments made with respect to claim 9 under the heading of "(1) Remoteness Criteria Not Satisfied by the Examiner's Combination."

*Claim 21*

With respect to claim 21, Applicants hereby incorporate by reference the arguments made with respect to claim 9.

*Claim 25*

With respect to claim 25, Applicants hereby incorporate by reference the arguments made with respect to claim 13.

*Claim 26*

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With respect to claim 26, Applicants hereby incorporate by reference the arguments made with respect to claim 14.

***Claim 27***

With respect to claim 27, Applicants hereby incorporate by reference the arguments made with respect to claim 15.

***Claim 28***

With respect to claim 28, Applicants hereby incorporate by reference the arguments made with respect to claim 16.

***Claim 29***

With respect to claim 29, Applicants hereby incorporate by reference the arguments made with respect to claim 17.

***Claims 30 through 35***

The Examiner's rejection of claims 30 through 35 is based on the Examiner's combination of Kobayashi and Oseto. As established in Applicants initial argument entitled "*Initial Argument Applicable to All Pending Claims*", the Examiner's statement of motivation is based on other than evidence of record. These claims are believed to be patentable for at least those reasons.

***New Claims 40 and 41***

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Claims 40 and 41 are newly introduced claims which require the selection and delivery of a singly captured document to all three routes and destinations specified. These claims have been introduced specifically to obviate the Examiner's argument with respect to claims 30 through 35 that the claim language specified in step 2 it is not required – it is now required. Claims 40 and 41 require that a user be able to select delivery of the singly captured document to each and all of the interfaces specified, and that according to such selection, deliver that document accordingly to **each and all** of the printer, the first network interface as an electronic mail message containing the digital record, and the second network interface to generate a facsimile transmission to a remote facsimile receiver.

There is no disclosure or suggestion in the Examiner's combination of Kobayashi and Oseto for the selection of delivery of a singly captured document to three destinations of any kind, much less the three Interfaces specified. Not only is there no selection, there is also no delivery of a singly captured document to all three destinations, based on a user's selection, much less so in the three formats specified.

*Claim 36 and 37*

Applicants incorporate by reference the arguments made above with respect to claim 9 under the headings "(1) Remoteness Criteria Not Satisfied by the Examiner's Combination," and "(2) Kobayashi's LAN 500-4 Does Not Meet Applicants' '... second network interface...' Requirement" since claim 36 and 37 include those limitations argued with respect to claim 9.

In addition, Applicants incorporate herein by reference the arguments made above with respect to claim 14 in dealing with the "each and all" limitation since this limitation is also expressly recited in claims 36 and 37. Claims 36 and 37 are believed to be patentable for at least those reasons argued with respect to claim 14. Claims 36

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and 37 require that a user be able to select delivery of the singly captured document to each and all of the interfaces specified, and that according to such selection, deliver that document accordingly to **each and all** of the printer interface (or printer), the first network interface, and the second network interface. As asserted above, the Examiner's combination fails to show these expressly recited limitations.

*Revisitation of the Examiner's Motivation to Combine*

As presented above in the initial arguments, it is Applicants position that the Examiner has provided a motivation to combine which is not based on evidence of record. Notwithstanding, should the Examiner provide such evidence in an ensuing Official Action, Applicants would like to further include arguments relative to the Examiner's motivation to combine. Applicants are presenting these further arguments now for the purpose of entering the them as early as possible into the record. These specific arguments are additionally applicable to all claims which include a limitation to "... a second database of address information stored remotely from said controller and accessible through said first network interface. . . ." Specifically, these arguments additionally apply to claims 9, 13, 17, 21, 25, 29, 36, 37 and new claim 42.

*Additional argument for claims 9, 13, 17, 21, 25, 29, 36, 37 and new claim 42*

It eludes Applicants why the Examiner would select the motivation to combine which is presently being proffered. The motivation to combine which is presently being proffered is repeated here for convenience and clarity:

"... to provide the ability to send and receive e-mail to and from other terminals machines through the LAN, **without utilizing a system server for database information.**" (Bold emphasis added)

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Bold emphasis is supplied above to illustrate that the motivation requires **non** use of a system server for database information. For the claims presented, this statement of motivation appears to oppose and contradict the combination the Examiner is required to make in order to properly assemble a *prima facie* case of obviousness. The contradiction becomes evident when one considers that these claims require a *system server for database information* by virtue of the expressly recited language:

"... a second database of address information stored  
remotely from said controller and accessible through said  
first network interface. . . ."

Yet the Examiner's statement of motivation precludes a *system server for database information*. Applicants assert that it is well-known to persons of ordinary skill in the art that a database which is accessed over an area network (the limitation "area network" found in each of these claims is associated with the first network interface through which the second database of address information is accessed) is typically accessed via a server. This assertion is consistent with the Examiner's use of the same terminology, namely: "... server for database information . . . ." therefore, the claim terminology

"... a second database of address information stored  
remotely from said controller and accessible through said  
first network interface. . . ."

equates to the Examiner's terminology

"... system server for database information . . . ."

In other words, if the letter A were used to represent the portion of the Examiner's statement "... a system server for database information ...," then, from a very high level it appears to Applicants that the Examiner is presenting an irrational case. It appears to Applicants that the Examiner is presenting that the combination of

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Kobayashi and Oseto includes A and the motivation for combining the references is to send and receive e-mail's **without utilizing A.**

Applicants submit that sources of rationale supporting a rejection under 35 USC 103 must be logical and convincing. Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

***New Claim 42***

The arguments made immediately above appear to be incontrovertible. Notwithstanding, should the Examiner argue that the claim recitation

". . . a second database of address information stored  
remotely from said controller and accessible through said  
first network interface. . ."

only implies a server and does not explicitly call one out, new claim 42 explicitly calls out that which is already inherent in Applicants claim in order to obviate this potential argument. Claim 42 recites the following bold highlighted language:

". . . a second database **server** of address information  
stored remotely from said controller and accessible through  
said first network interface. . ."

As newly introduced, claim 42 expressly recites that which the Examiner's statement of motivation precludes. Therefore, Claim 42 is believed to be patentable and in condition for immediate allowance.

Claim 42 is further believed to be patentable for those reasons given with respect to claim 9. Applicants hereby incorporate by reference the arguments made with respect to claim 9 as claim 42 includes all of the limitations of claim 9.

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**Request to Proceed to Allowance**

For each and all of the reasons set forth above, and as Applicants believe each and all of Examiner's rejections and or objections have been traversed or rendered moot, Applicants respectfully request that this response be considered, entered, and a timely notice of allowance be issued.

The Examiner is urged to call the undersigned at the below-listed telephone number if, in the Examiner's opinion, such a phone conference would expedite or aid in the prosecution of this application.

Respectfully Submitted,



Carlos Munoz-Bustamante

Reg. No. 51,349

IBM Corporation  
Personal and Printing Systems Group  
Intellectual Property Law  
Department 9CCA/Building 002-2  
P. O. Box 12195  
Research Triangle Park, NC 27709

(919)254-2587  
FAX: 919-254-2649  
EMAIL: cbustama@us.ibm.com

S.N.: 09/557,118

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Appendix A

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As a noun, an interface is either:

1. A user interface, consisting of the set of dials, knobs, operating system commands, graphical display formats, and other devices provided by a computer or a program to allow the user to communicate and use the computer or program. A graphical user interface (GUI) provides its user a more or less "picture-oriented" way to interact with technology. A GUI is usually a more satisfying or user-friendly interface to a computer system.
2. A programming interface, consisting of the set of statements, functions, options, and other ways of expressing program instructions and data provided by a program or language for a programmer to use.
3. The physical and logical arrangement supporting the attachment of any device to a connector or to another device.

As a verb, to interface means to communicate with another person or object. With hardware equipment, to interface means making an appropriate physical connection so that two pieces of equipment can communicate or work together effectively.

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APPENDIX A.

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## Appendix B

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## interface

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(n.) A boundary across which two independent systems meet and act on or communicate with each other. In computer technology, there are several types of interfaces.

- user interface - the keyboard, mouse, menus of a computer system. The user interface allows the user to communicate with the operating system. Also see [GUI](#).
- software interface - the languages and codes that the applications use to communicate with each other and with the hardware.
- hardware interface - the wires, plugs and sockets that hardware devices use to communicate with each other.

(v.) To connect with or interact with by means of an interface.

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APPENDIX B.

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